

ESTTA Tracking number: **ESTTA776692**

Filing date: **10/14/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

### Petitioner Information

Name	Dansk Mjød A/S		
Entity	aktieselskab	Citizenship	Denmark
Address	13, 7190 Billund, DENMARK		

Domestic Representative	Eric T. Fingerhut Attorney for Petitioner Dykema Gossett PLLC 1301 K Street, N.W. Suite 1100 West Washington, DC 20005 UNITED STATES ipmail@dykema.com
-------------------------	--

### Registration Subject to Cancellation

Registration No	4042838	Registration date	10/18/2011
Registrant	Vifillfell hf. Studlahalsi 1 110 Reykjavik, ICELAND		

### Goods/Services Subject to Cancellation

Class 032. First Use: 2005/05/29 First Use In Commerce: 2005/05/29  
All goods and services in the class are cancelled, namely: Beer

### Grounds for Cancellation

No use of mark in commerce before application, amendment to allege use, or statement of use was filed	Trademark Act Sections 14(1) and 1(a), (c), and (d)
Abandonment	Trademark Act Section 14(3)
Fraud on the USPTO	Trademark Act Section 14(3); In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)
Other	Registration is Void Ab Initio

Attachments	Petition for Cancellation VIKING.pdf(92811 bytes )
-------------	--

## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/eric fingerhut/
Name	Eric Fingerhut
Date	10/14/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**In re Registration No. 4,042,838**  
**Mark: VIKING**  
**Issued: October 18, 2011**

Dansk Mjød A/S	)	
	)	
	)	
	)	
vs.	)	Cancellation No. _____
	)	
Vifilfell hf.	)	
	)	
	)	
	)	

**PETITION FOR CANCELLATION**

Petitioner Dansk Mjød A/S, a Danish aktieselskab, having its principal place of business at 13, 7190 Billund, Denmark, believes it will be damaged by Registration No. 4,042,838 of the mark VIKING and hereby petitions to cancel same.

The grounds for the cancellation are as follows:

**PETITIONER AND ITS VIKING BLOD MARK**

1. Petitioner is a brewer of honey wine, mead, beer and other spirits, a producer of foodstuffs such as mustard, pesto, and salts and confections such as licorice and jams. Petitioner has been using the mark VIKING BLOD for honey wine and mead in commerce in the United States since October 5, 2006 and Petitioner's VIKING BLOD mead honey wine and mead is available for sale at various retail outlets in the United States. As a result of Petitioner's long and continuous commercial use, the mark VIKING BLOD is recognized and relied upon by the public

and trade as identifying and distinguishing the goods of Petitioner, and representing the valuable goodwill and reputation of Petitioner.

2. On June 10, 2015, Petitioner filed a use-based application to register the mark VIKING BLOD with the United States Patent and Trademark Office ("USPTO"), Serial No. 86/657,348, covering "honey wine; mead" in Class 33.

3. On September 21, 2015, the examining attorney from the USPTO issued an Office Action refusing to register Petitioner's mark, citing Registrant's "VIKING" mark, Registration No. 4,042,838, as grounds for refusal based on likelihood of confusion under Trademark Act Section 2(d).

4. Applicant eventually persuaded the examining attorney to withdraw the Section 2(d) refusal; however, on June 17, 2016 Registrant sent Petitioner a cease-and-desist letter objecting to Petitioner's use and registration of the mark VIKING BLOD for honey wine and mead. Although Petitioner maintained its use and registration of the mark VIKING BLOD for honey wine and mead was not likely to cause confusion as to the source of these goods, Petitioner decided to abandon its application rather than defend its right to register the mark VIKING BLOD in an opposition proceeding. Petitioner's decision to abandon was voluntary and not pursuant to any agreement with or obligation to Registrant. Moreover, as noted above in Par. 1. above, Petitioner continues to sell VIKING BLOD honey wine and mead and Registrant has not raised any further objection to Registrant's use since Petitioner's voluntary abandonment of its application.

## **REGISTRATION OF VIKING**

5. Registrant Vifilfell hf. is an Icelandic hlutafélag (limited liability company) having its principal place of business at Studlahalsi 1 110 Reykjavik ICELAND.

6. Registration No. 4,042,838 of the mark VIKING (hereinafter the "Registration") issued to Registrant on October 18, 2011, for "beer" in Class 32.

7. On August 18, 2011, Registrant filed with the United States Trademark Office a Statement of Use in support of its then pending application in which Registrant claimed that "the mark [VIKING] is in use in commerce on or in connection with the following goods or services listed in either the application or Notice of Allowance or as subsequently modified for this specific class: Beer."

8. The Statement of Use Registrant filed on August 18, 2011 included a sworn declaration signed under 18 U.S.C. Section 1001 by Mr. Gudjon Gudmundsson, Marketing & Sales Director for Registrant.

9. Mr. Gudmundsson's Declaration stated that as of August 17, 2011 "the mark [VIKING] is in use in commerce" for beer.

10. In support of its August 18, 2011 Statement of Use, Registrant attached a specimen of use consisting of photographs of a bottle of beer and a six pack of beer displaying the mark VIKING.

11. Upon information and belief, Registrant has not used the mark VIKING for beer in commerce in the United States for at least the past three (3) years.

## **CANCELLATION OF REGISTRATION UNDER 15 U.S.C. § 1064(3)**

12. Petitioner incorporates herein by reference each and every allegation in the preceding paragraphs 1 – 11.

13. Petitioner is informed and believes that Registrant has abandoned the VIKING mark by discontinuing the use of such mark in commerce in the ordinary course of trade for beer as specified in Registration No. 4,042,838 with intent not to resume said use.

14. Upon information and belief, Registrant has not used the mark VIKING for beer in commerce in connection with beer since 2005. This period of non-use is well-beyond the three year period of non-use a petitioner must prove for a prima facie case of abandonment.

15. Petitioner is damaged by the continued existence of Registration No. 4,042,838 for the abandoned mark VIKING as the existence of such registration may prevent Petitioner from importing, advertising, and/or selling honey wine and mead under its VIKING BLOD mark and/or subject Petitioner to liability based therefrom, and has already prevented Petitioner from obtaining a registration for VIKING BLOD as Registrant's assertion of its alleged trademark rights caused Petitioner to voluntarily abandon its application, Serial No. 86/657,348.

#### **THE REGISTRATION OF VIKING IS VOID AB INITIO**

16. Petitioner incorporates herein by reference each and every allegation in the preceding paragraphs 1 – 15.

17. Registration No. 4,042,838 for mark VIKING is based on use in commerce of the VIKING mark for the goods identified in the application, and sets forth the date of first use in commerce of the mark VIKING as May 29, 2005. The application, Serial No. 78/876,394 ("the '394 Application"), was filed on May 4, 2006 and the Statement of Use of the mark VIKING for beer was filed on August 18, 2011.

18. Registration No. 4,042,838 for mark VIKING is void *ab initio* on its face, as the VIKING mark was not in use in commerce as of the filing date of the Statement of Use in the '394 Application.

19. On information and belief, as of the August 18, 2011 filing date of the Statement of Use in the '394 Application which matured into Registration No. 4,042,838, no VIKING beer had been sold by Registrant in commerce, and/or Registrant was not engaged in the bona fide sale of beer in commerce, under and/or in connection with the mark VIKING.

20. By reason of the foregoing, Registration No. 4,042,838 of the mark VIKING is void *ab initio*.

**FRAUD IN PROSECUTING APPLICATION NO. 78/876,394 BEFORE THE  
USPTO**

21. Petitioner incorporates herein by reference each and every allegation in the preceding paragraphs 1 – 20.

22. On May 4, 2006, Registrant applied to register the mark VIKING with the USPTO, Serial No. 78/876,394 ("the '394 Application"). In that application, Registrant signed a declaration under Section 1101 of Title 18 of the United States Code in support of the '394 Application, stating, among other things, that "all statements made of his/her own knowledge are true."

23. Petitioner is informed and believes that at the time Registrant filed the Statement of Use in the '394 Application on August 18, 2011, the VIKING mark was in fact **not** used for beer in commerce as defined by 15 U.S.C. Section 1051 et seq.

24. Registrant knew that VIKING was not in use in commerce for beer as of August 17, 2011 when it signed the Statement of Use and on August 18, 2011 when the Statement of Use was filed with the USPTO.

25. Petitioner is informed and believes that at the time Registrant signed the declaration in support of the Statement of Use in the '394 Application, Registrant knew or acted in reckless disregard of the truth that it did not in fact use the mark VIKING in commerce for beer and/or was not in fact currently using the mark in commerce for beer at the time the Statement of Use was filed.

26. Petitioner is informed and believes that, at the time, Registrant acknowledged and accepted the warning "that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of the application or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true", yet executed the declaration nonetheless knowing such statements to be false.

27. The USPTO accepted and relied upon material misrepresentations by Registrant in accepting the Statement of Use and approving the '394 Application for registration, namely, that the mark was in use in commerce for beer when, in fact, it wasn't.

28. Petitioner is informed and believes that Registrant intended to procure a registration to which it was not entitled, and thus committed fraud on the USPTO, by failing to provide truthful representations as to whether Registrant was currently using VIKING in commerce at the time the Statement of Use was filed.



29. Upon information and belief, Petitioner alleges the statement of current use in commerce set forth in the Statement of Use filed August 18, 2011 was false at the time it was made because Registrant was not using the mark VIKING for in commerce for beer.

30. Upon information and belief, Registrant knew or should have known that its statement regarding use of the mark VIKING for beer in commerce in the Statement of Use was false at the time such statement was made.

31. The statement regarding use of the mark VIKING for beer in commerce in the Statement of Use is material because the United States Patent and Trademark Office relied upon Registrant's material false statement in approving the Statement of Use and granting the Certificate of Registration of the mark VIKING for beer.

32. Petitioner is being damaged by the continued existence of Registration No. 4,042,838 on the register because that registration is hampering Petitioner's ability to register its mark VIKING BLOD for mead and honey wine.

**WHEREFORE,** Petitioner is being damaged by Registration No. 4,042,838 and respectfully requests that this petition for cancellation be granted, and that Registration No. 4,042,838 be cancelled.

The requisite filing fee for this Petition for Cancellation is submitted herewith.

Dansk Mjød A/S

Dated: October 14, 2016

/eric t. fingerhut/

By: \_\_\_\_\_

Eric T. Fingerhut  
Dykema Gossett PLLC  
1301 K Street, NW  
Suite 1100 West  
Washington, DC 20005  
(202) 906-8618  
Email: efingerhut@dykema.com  
Attorney for Petitioner

Certificate of Service

In accordance with Rule 2.119 of the Trademark Rules of Practice, it is hereby certified that a true copy of the foregoing Petition for Cancellation was served on counsel for Registrant, as identified below, by depositing same in the U.S. mail, first class postage prepaid, this 14<sup>th</sup> day of October, 2016:

Edward T. White  
LeClairRyan  
919 East Main Street  
Twenty-Fourth Floor  
Richmond, VIRGINIA 23219-4074

/eric t. fingerhut/

\_\_\_\_\_